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EXAMINER
MURDOUGH, JOSHUA A

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *24 April 2008*.
2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-21* is/are pending in the application.
    4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5)☐ Claim(s) _____ is/are allowed.
6)☒ Claim(s) *1-21* is/are rejected.
7)☐ Claim(s) _____ is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.
10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    a)☐ All   b)☐ Some * c)☐ None of:
      1.☐ Certified copies of the priority documents have been received.
      2.☐ Certified copies of the priority documents have been received in Application No. _____.
      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date *1/17/2008, 1/17/2008, 3/7/2008, 6/17/2008*.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____ .

DETAILED ACTION

Acknowledgements

1.   This action is responsive to Applicants' amendments received on 24 April 2008

2.   Claims 1-21 are pending and have been examined.

Information Disclosure Statement

3.   Upon further review, the document contained in the IDS entered on 1/17/2008 has a date

of publication that can be determined. Therefore, it has now been considered by the Examiner,

as indicated by the attached 1449.

Claim Objections

4.   Claim 21 is objected to because of the following informalities: At the end of line 11

there is a period. Claims are to be only one sentence in length. As a period usually ends a

sentence, this period could be interpreted to signify the end of the claim. However, the Examiner

has interpreted it as merely a typo, with a semicolon being the intended punctuation.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

5.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed
> in the United States before the invention by the applicant for patent or (2) a patent granted on an application for
> patent by another filed in the United States before the invention by the applicant for patent, except that an

international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6.   Claims 1-17 are rejected under 35 U.S.C. §102(e) as being anticipated by Ginter (7,133,846).

7.   As to claim 1, Ginter shows:

a.   A computer-implemented system for accessing digital content, the system comprising a media device (Figure 1B, element 104) wherein said media device further comprises:

b.   a digital rights management system (Abstract); and

c.   a rating engine (functionally shown in Columns 117-118, lines 60-20);

d.   wherein said media device said digital rights management system, and said rating engine are utilized by a consumer to perform the following function:

e.   download a digital content package (Figure 4, any of elements 152a-i);

f.   create a license rights package to be associated with said digital content package, said license rights package includes debitable parameters for accessing said digital content package (Figure 11, element 302);

g.   purchase said license rights package (Figure 10) wherein said license rights package includes an account number for said consumer (an account number and transit routing number are needed to process clearinghouse transactions as shown in Figure 10);

h.   download said license rights package to said media device (Column 111, lines 19-29);

     i.   debit said license rights package when said consumer accesses said digital content

              package in accordance with a set of rights included in said license rights package

              (Column 111, lines 38-46);

     j.   when said license rights package is exhausted, renew said license rights package

              without contemporaneously connecting to a host system (delayed, Column 19,

              lines 26-27) by storing a charge associated with (in order to delay the

              transmission, it has to be stored, Id.) said account number contained in said

              license rights package for selective transmittal to the host system (periodic or

              other event driven, Id.) (Column 114, lines 49-55).

8.   As to claim 4, Ginter further shows:

     said digital rights management system may access a license storage (the license being

              implemented through the metering mechanism, Figure 1B, element 116) on said

              media device to determine if a set of license rights exist for an access desired by

              said consumer (Column 17, lines 39-49).

9.   As to claim 5, Ginter further shows:

     said digital rights management system will not allow access to said digital content

              package if an associated license rights package is not available (the certificate

              contained within the package needs to be present to allow access, Column 118,

              lines 26-34).

10.   As to claim 6, Ginter further shows:

said digital rights management system will prompt said consumer to procure a license

rights package if said license rights package does not exist in said license storage

(Column 28, lines 54-62).

11.   As to claim 7, Ginter further shows:

said digital rights management system will prompt said consumer to renew a license

rights package if said license rights package has been debited enough to trigger a

predetermined expiration warning (Columns 28-29, lines 63-6).

12.   As to claim 8, Ginter further shows:

said digital rights management system will prompt said consumer to procure additional

rights for a license rights package if said license rights package does not include

said additional rights (Figure 45A, all of the purchasable rights are stored in the

rights template along, if a consumer wishes to perform an action for which the

rights have not been purchased, they will have to purchase the rights prior to the

action; Column 75, lines 9-39).

13.   As to claim 9, Ginter further shows:

k.   wherein said license rights package (original license rights package) further

comprises metadata (Figure 45C, element 188) which may be utilized by said

rating engine to:

l.   calculate a cost for an additional license rights package without

contemporaneously connecting to a host system (Columns 28-29, lines 63-6,

When the original permissions were downloaded, the information regarding the

price was acquired, not when the rights are purchased); and

m.   create a new license rights package further comprising said account number

associated with said original license rights package (inherently, a package must be

modified, thus creating an new package to reflect the new rights);

n.   selectively transmit a charge associated with said additional license rights package

and said account number associated with said additional license rights package to

said host processor (debit the consumers electronic wallet, Column 29, lines 3-6).

14.   As to claim 10, Ginter further shows:

o.   wherein said license rights package (original license rights package) further

comprises metadata (Figure 45C, element 188) which may be utilized by said

rating engine to:

p.   calculate a cost for an additional license rights package without

contemporaneously connecting to a host system (Columns 28-29, lines 63-6,

When the original permissions were downloaded, the information regarding the

price was acquired, not when the rights are purchased); and

q.   modify said license rights package to include said set of additional

rights(inherently, a package must be modified, thus creating an new package to

reflect the new rights);

r.   selectively transmit a charge associated with said additional license rights package

and said account number associated with said additional license rights package to

said host processor (debit the consumers electronic wallet, Column 29, lines 3-6).

15.   As to claim 11, Ginter further shows:

said additional license rights package may be structured to provide rights on a per use

basis (Figure 45A, pay per use/action/view pricing modles).

16.   As to claim 12, Ginter further shows:

said additional license rights package may be structured to provide rights on a time spent

basis (Columns 54-55, lines 62-7).

17.   As to claim 13, Ginter further shows:

said additional license rights package may be structured to provide rights on a

subscription basis (Column 79, lines 7-11).

18.   As to claim 14, Ginter further shows:

said additional license rights package may be structured to provide rights according to a

quantum of digital content accessed basis (Column 54, lines 26-39, e.g. first

chapter is free, additional chapters cost).

19.   As to claim 15, Ginter further shows:

said additional license rights package may be flexibly structured to provide rights

according to the preferences of a customer (Figure 45A, The template shows all of

the purchasable rights, but the customer only has to purchase the ones they

prefer).

20.   As to claim 16, Ginter shows:

s.   A computer-implemented system for accessing digital content, the system

comprising a media device (Figure 2B, element 100) further comprising

t.   a digital rights management system (Abstract) and a rating engine (Column 75,

lines 9-19, element 450);

u.   a content server (Figure 21, element 168, for digital content over a network, the publisher would have to be a content server); and

v.   a license server wherein said content server is configured to store and index digital content (Figure 11, element 300);

w.   said license server is configured to store a plurality of data and algorithms (Figure 11, elements 302 and 304a-d) to be associated with a particular set of digital content (digital content package) (Figure 11, elements 152a-e)

x.   said media device is configured to access said content server to:

y.   search said content server for said particular digital content package (Figure 11, element 152b);

z.   download said digital content package to said media device (Figure 11, element 152b, download shown by arrow to device comprising elements 102, 104, 106, 116 and 154) wherein said digital content package is further configured with an identifier (inherent to include an identifier, in order for the package to be accessed); and

aa.   said media device is configured to access said license server (Figure 11, arrow from device comprising elements 102, 104, 106, 116 and 154 to element 300) to:

bb.   access a set of data and algorithms associated with said selected digital content package via said identifier (Figure 17D-3, 90B);

cc.   create a license rights package for said downloaded digital rights (Figure 11, element 302);

dd.   charge said license rights package to an account associated with a consumer

procuring said license rights package, said license rights package includes

debitable parameters for accessing said digital content package (Figure 10);

ee.   incorporate said account number in said license package for future charges (an

account number and transit routing number are needed to process clearinghouse

transactions as shown in Figure 10);

ff.   download said license rights package to said media device (Column 111, lines 19-

29); and

gg.   said digital rights management system:

hh.   confirms a license rights package exists when said consumer attempts to access

said digital content package on said media device (Column 17, lines 39-49);

ii.   if a desired access is included on said license rights package;

jj.   said digital rights management system debits said license package for said desired

access and permits said access (Column 28, lines 54-62); and

kk.   said rating engine is configured to:

ll.   permit said license rights package to be modified when said media device is not

contemporaneously connected to a host system (delayed, Column 19, lines 26-

27);

mm.   store a charge for a modification (in order to delay the transmission, it has to be

stored, Id.), said charge associated with said account number (needed to in

payment information in order to process the payment, Id.); and

nn.   selectively transmit said charge to said host system (periodic or other event
driven, Id.).

21.   As to claim 17, Ginter further shows:

said digital rights management system is further configured so that if a desired access is
not included in said license rights package, said digital rights management system
prompts said consumer to renew or extend said license rights package (Column
28, lines 54-62) by charging a renewal or extension to said account number
associated with the inadequate license rights package (Column 114, lines 49-55).

22.   As to claim 18, Ginter shows:

oo.   A computer-implemented system for accessing digital content,

pp.   the system comprising a media device (Figure 1B, element 104), said media
device further comprises:

qq.   a digital rights management system (Abstract); and

rr.   a rating engine (functionally shown in Columns 117-118, lines 60-20);

ss.   said media device, said digital rights management system, and said rating engine
utilized by a consumer to perform the following function:

tt.   download said license rights package (Column 111, lines 19-29) and a digital
content package (Figure 4, any of elements 152a-i) to said media device, said
license rights package (Figure 11, element 302)includes an account number
associated with said first consumer and debitable parameters for accessing said

digital content package (an account number and transit routing number are needed

to process clearinghouse transactions as shown in Figure 10);

uu.   transfer said digital content package and said license rights package to a second

consumer (Column 97, lines 43-51);

vv.   debit said license rights package when said second consumer accesses said digital

content package in accordance with a set of rights included in said license rights

package (Column 111, lines 38-46);

ww.   modify said license rights package without contemporaneously connecting to a

host system (delayed, Column 19, lines 26-27) by storing a charge associated with

said account number contained in said license rights package (in order to delay

the transmission, it has to be stored, Id.) for selective transmission to the host

system (periodic or other event driven, Id.).

23.   As to claim 2, Ginter further shows:

when said license rights package is exhausted, said second consumer may renew said

license rights package by charging said account number contained in said license

rights package (A new user cannot be allowed to incur charges on the first user's

account, therefore it is inherent that when contents are redistributed, as shown in

Ginter (Column 131, lines 38-49), the account information is changed).

24.   As to claim 3, Ginter further shows:

when said license rights package is exhausted, said second consumer may renew said

license rights package by charging, at said second consumer's option, a new

account number and a new license rights package will contain said new account

number (A new user cannot be allowed to incur charges on the first user's

account, therefore it is inherent that when contents are redistributed, as shown in

Ginter (Column 131, lines 38-49), the account information is changed. The

second consumer has to provide this account information, and therefore has the

option as to what information is provided.).

25.   As to claim 19, Ginter further shows:

xx.   said license rights package further comprises metadata which may be utilized by

said rating engine to:

yy.   calculate a cost to renew said license rights package (Column 110, line 63);

zz.   modify said license rights package to renew said license rights package (Figure

10);

aaa.   store said charge associated with said account number for said renewal (in order

to delay the transmission, it has to be stored, Column 19, lines 26-27); and

bbb.   electively transmit said charge to said host system at a time when said media

device is connected to said host system (periodic or other event driven, Id.).

26.   As to claim 20, Ginter further shows:

ccc.   said license rights package further comprises metadata which may be utilized by

said rating engine to:

ddd.   calculate a cost for additional rights in said license rights package; modify said

license rights package to include said additional rights (Columns 72-73, lines 54-

4);

eee.   store said charge associated with said account number for said additional rights

(in order to delay the transmission, it has to be stored, Column 19, lines 26-27);

and

fff.   selectively transmit said charge to said host system at a time when said media

device is connected to said host system (periodic or other event driven, Id.).

27.   As to claim 21, Ginter shows:

ggg.   A computer readable medium for accessing digital content, the computer readable

medium having computer executable instructions stored thereon to configure a

media device (Figure 1B, element 104) to perform the steps comprising:

hhh.   downloading a digital content package to said media device (Figure 4, any of

elements 152a-i);

iii.   creating a license rights package including an account number and debitable

parameters for accessing said digital content package (Figure 11, element 302);

jjj.   purchasing said license rights package (Figure 10);

kkk.   downloading said license rights package to said media device (Column 111, lines

19-29);

lll.   accessing a license storage on said media device (the VDE container includes the

license, and as it is shown being transferred to the device, inherently the access is

provided on the device, Column 111, lines 19-29);

mmm. determining if said license rights package is available in said license storage for

an access desired by a consumer (Column 51, lines 58-62).

nnn.   prohibiting access to said digital content package if said license rights package is

not available for said access desired by said consumer (Column 96, lines 54-67) ;

ooo.   prompting said consumer to procure said license rights package if said license

rights package is not available in said license storage (Columns 108-109, lines 61-

5);

ppp.   debiting said license rights package when said consumer accesses said digital

content package in accordance with license rights included in said license rights

package (Column 109, lines 6-11);

qqq.   and modifying said license rights package without contemporaneously connecting

to a host system (delayed, Column 19, lines 26-27),

rrr.   the step of modifying further comprising using metadata included with said

license rights package to:

sss.   calculate a cost for modifying said license rights package (Columns 28-29, lines

63-6);

ttt.   modify said license rights package (inherently, a package must be modified, thus

creating an new package to reflect the new rights);

uuu.   store a charge associated with said account number contained in said license

rights package for said modification (in order to delay the transmission, it has to

be stored, Column 19, lines 26-27); and

vvv.   selectively transmit said charge to a host system at a time when said media device

is connected to said host system (periodic or other event driven, Id.) (Column 114,

lines 49-55).

Claim Interpretation

28.   As per claims 2-17 and 21 the Examiner interprets claim limitations that contain *"if, may,*

might, can, when and could" statement(s), as optional language. As matter of linguistic precision,

optional claim elements do not narrow claim limitations, since they can always be omitted.

Language that suggests or makes optional but does not require steps to be performed or does not

limit a claim to a particular structure does not limit the scope of a claim or claim limitation. For

the sake of speeding up the prosecution process, the Examiner has taken these limitations into

account, but they will not be given patentable weight unless positively recited.

29.   Claims 1-19 are understood to be apparatus claims. As such, they are subject to

interpretation as outlined by MPEP § 2114, wherein it says, "While features of an apparatus may

be recited either structurally or functionally, claims directed to an apparatus must be

distinguished from the prior art in terms of structure rather than function" and "[A]pparatus

claims cover what a device is, not what a device does." While the Examiner has cited references

for the functional limitations that do not require an alteration of the structure for purposes of

compact prosecution, it is his principal position that these elements do not need to be shown in

order to show anticipation. It is suggested that the claims be amended to clearly show the

structural elements to prevent issues associated with this type of interpretation.

30.   Words such as "configured" or "operable" (e.g. Claim 16, "content server is configured

to store and index digital content") are considered to set out intended use as they merely indicate

a set up and not a function that must be performed. Essentially, the system must be capable of

performing the function. However, if the claims are amended to recite that the system is

"programmed to" perform the function, it would be considered as imparting structure and

therefore would be given full patentable weight.

Definitions

31.   To the extent that the Examiner's interpretations are in dispute with Applicants'

interpretations, the Examiner hereby adopts the following definitions—under the broadest

reasonable interpretation standard—in all his claim interpretations.[1] Moreover, while the

following list is provided in accordance with *In re Morris (127F.3d 1048, 44 USPQ2d 1023*

(Fed. Cir 1997)), the definitions are a guide to claim terminology since claim terms must be

interpreted in context of the surrounding claim language. Finally, the following list is not

intended to be exhaustive in any way:

> *Metadata*: "n. Data about data. For example, the title subject, author, and size of a file
>
> > constitute meta data about the file." Computer Dictionary, 3rd Edition, Microsoft
> >
> > Press, Redmond, WA, 1997.
>
> *Server*: "2. On the Internet or other network, a computer or program that responds to
>
> > commands from a client." Computer Dictionary, 3rd Edition, Microsoft Press,
> >
> > Redmond, WA, 1997.
>
> *If:* "1 a : in the event that" Webster's Ninth New Collegiate Dictionary, Merriam-
>
> > Webster Inc., Springfield, M.A., 1986.

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[1] While most definition(s) are cited because these terms are found in the claims, the Examiner
may have provided additional definition(s) to help interpret words, phrases, or concepts found in
the definitions themselves or in the prior art.

May: "1 a archaic : have the ability to." <u>Webster's Ninth New Collegiate Dictionary</u>.

Merriam-Webster Inc., Springfield, M.A., 1986.

Configure: "to set up for operation esp. in a particular way." <u>Webster's Ninth New</u>

<u>Collegiate Dictionary</u>, Merriam-Webster Inc., Springfield, M.A. 1986.

Set up: "2 b : to assemble the parts of and erect in position." <u>Webster's Ninth New</u>

<u>Collegiate Dictionary</u>, Merriam-Webster Inc., Springfield, M.A. 1986.

Response to Arguments

32.   Applicant's arguments filed 24 April 2008 have been fully considered but they are not

persuasive.

33.   <u>Applicants argue</u>:

"Furthermore, the prior art of record fails to teach or suggest a rating engine as claimed in the

present application." (Remarks, Page 13, paragraph 1)

34.   <u>Examiner's response</u>:

The Examiner respectfully disagrees. Ginter does in fact show a rating engine as described in

the instant application. The Examiner has modified the citations above to more clearly show the

corresponding functionality. Ginter clearly shows presenting a rate for a particular right, such as

viewing (Columns 117-118, lines 60-20).   Moreover, Ginter provides a similar example to the

one set out by Applicants in paragraph [0082] (Columns 110-111, lines 22-45).

35.   Applicants argue:

"Considering claims 16 and 17, these claims do not include optional language when properly interpreted. " (Remarks, Page 14, Paragraph 1)

36.   Examiner's response:

In support of this position, Applicants quote MPEP 2111.04 as it relates to "whereby" clauses. However, this is unrelated to the Examiner's position. The Examiner clearly stated "*if, may, might, can, when and could*" as the words that make the limitations optional. Of particular importance are "if" and "may." The definitions of these words have been provided above to support the Examiner's position. Both of these words provide for at least two distinct options. Upon satisfaction of the condition associated with the word, something is to be done. However, if that condition is not satisfied, something else is to be done. Since the alternative has not been set out in the claims, the Examiner has interpreted that nothing is to be done. Therefore, a system or method where the condition is not met reads on the claim regardless of what may or may not be done after that. If the claims were amended to show that the condition is necessarily satisfied, the alternate could not read on the claims and thus the limitations would have to be present. Since that is not currently the case, the Examiner maintains his position on this issue.

Conclusion

37.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time

policy as set forth in 37 CFR 1.136(a).

38.   A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the mailing

date of this final action.

39.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to JOSHUA MURDOUGH whose telephone number is (571)270-

3270. The examiner can normally be reached on Monday - Thursday, 7:00 a.m. - 5:00 p.m.

40.   If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Andrew Fischer can be reached on (571) 272-6779. The fax phone number for the

organization where this application or proceeding is assigned is 571-273-8300.

41.   Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would

like assistance from a USPTO Customer Service Representative or access to the automated

information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

J. M.
Examiner, Art Unit 3621

/ANDREW J. FISCHER/
Supervisory Patent Examiner, Art Unit 3621